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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/704,379	11/02/2000	Fred Bishop	10655.7600	4909

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EXAMINER

PATEL, JAGDISH

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/704,379

Applicant(s)


BISHOP ET AL.

Examiner

JAGDISH PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-10,15,16,18,19,21-25,34-42,47,48,50,51 and 53-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-10,15,16,18,19,21-25,34-42,47,48,50,51 and 53-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 04052001.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of restriction requirements in the reply filed on 10/5/2004 is acknowledged. The traversal is on the ground(s) that the search and examination of the entire application can be made without serious burden. This is not found persuasive because as explained in prior office action the restricted claims present serious burden due to their divergent subject matter.

The requirement is still deemed proper and is therefore made FINAL.

### *Response to Amendment*

2. Claims 1, 11-14, 17, 20, 26-33, 43-46, 49, 52 and 59-60 have been canceled. Claims 2, 4-6, 8, 10, 18, 21, 23-25, 34, 36-38, 40, 42, 47, 48, 50 and 53-58 have been amended.

3. Claims 2-10, 15-16, 18-19, 21-25, 34-42, 47-48, 50-51 and 53-58 are currently pending and have been examined.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 2-10, 15-16, 21-25, 34-42, 47,48, 53-58 are rejected under 35 U.S.C. 102(b) as being anticipated by Walker et al. (US 5,794,207). (hereafter Walker).

As per claim 6, Walker teaches a method of facilitating commercial transactions, which method comprises the steps of:

registering at least one of a first party and a second party with a transaction mechanism having a financial account identifier for identifying a financial account associated with said first party;

(see col. 8 L 66 - col. 9 L 5; col. 13 L 1-10 and Fig. 5; see col. 15 L 46+ CPO)

receiving from at least one of said first party and said second party least one of a request to debit a financial account of said first party to effectuate a transaction between said first party and said second party;

(col. 9 L 32-43, funds transfer)

receiving from at least one of said first party and said second party transaction information relating to said transaction between said first party and said second party;

(buyer creates a CPO, see col. 8 L 66 - col. 9 L 5)

determining whether said transaction is acceptable based upon at least one of said transaction information between said first party and said second party;

(see Fig. 6, col. 17 L 27-47, see col. 22 "Delayed Payment Embodiment")

debiting funds form financial account of said first party;

(see col. 22 "Delayed Payment Embodiment")

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disbursing funds to a financial account associated with said second party;

(see col. 22 "Delayed Payment Embodiment")

crediting said funds to said financial account associated with said second party.

(see col. 22 "Delayed Payment Embodiment")

Claim 2. The method of claim 6, wherein the step of debiting funds from said financial account of said first party comprises holding said funds in an escrow account until an escrow release event has transpired, and wherein the method comprises the step of releasing said funds from said escrow account prior to the step of disbursing said funds to a financial account associated with said second party.

(see col. 22 "Delayed Payment Embodiment")

Claim 3. The method of claim 2, wherein holding said funds in an escrow account until an escrow release event has transpired comprises holding said funds in an escrow account until an occurrence of at least one of a receipt by said first party of goods, services, or other value from said second party and a lapse of a predefined period of time within which said first party may evaluate said goods, services, or other value from said second party.

(see col. 22 "Delayed Payment Embodiment")

Claim 4. The method of claim 6, wherein receiving from at least one of said first party and said second party a request to debit a financial account associated with said first party comprises receiving a request to debit a financial account associated with said first party selected from the group consisting of a transaction card account, a demand deposit account, a credit line, and a money market account.

(see col. 20 "Payment preferences", At step 1300, the buyer selects his preferred method of payment. Preferred methods

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might include credit cards, personal checks, electronic funds transfer, digital money, etc.)

Claim 5. The method of claim 6, wherein disbursing said funds to a financial account associated with said second party comprises disbursing said funds to a financial account associated with said second party selected from the group consisting of a transaction card account, a demand deposit account, a credit line, a digital cash account, and a money market account.

(see col. 21 L 23-61)

Claim 7. The method of claim 6, wherein providing said transaction mechanism with a financial account identifier for identifying a financial account associated with said first party comprises providing a financial account identifier selected from the group consisting of a card number and a demand deposit account number.

(see col. 20 "Payment preferences", At step 1300, the buyer selects his preferred method of payment. Preferred methods might include credit cards, personal checks, electronic funds transfer, digital money, etc.)

Claim 8. The method of claim 6, wherein registering at least one of said first party and said second party comprises providing said transaction mechanism with a financial account identifier for identifying a financial account associated with said second party.

(see col. 21 L 23-61)

Claim 9. The method of claim 8, wherein providing said transaction mechanism with a financial account identifier for identifying a financial account associated with said second party comprises providing a financial account identifier selected from the group consisting of a card number and a demand deposit account number.

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(see col. 21 L 23-61)

Claim 10. The method of claim 6, wherein receiving transaction information relating to said transaction from at least one of said first party and said second party comprises at least one of receiving a financial account identifier associated with the financial account associated with said first party and receiving a financial account identifier associated with said financial account associated with said second party.

(see col. 21 L 23-61)

Claim 15. The method of claim 6, comprising the step of receiving notification that said first party has received goods, services, or other value shipped from said second party to said first party.

(see col. 22 "only after goods have been received by the buyer are the funds transferred ..", note that receiving notification is inherent because the central controller performs the escrow function)

Claim 16. The method of claim 6, comprising the step of providing an intermediary to facilitate said transaction between said first party and said second party.

(see for example, Fig. 1, refer to central controller 200 which performs the functions of an intermediary)

Claims 21-25 have been analyzed as per respective method claims 2-6. All limitations have been recited in the cited reference.

Claims 34-42 have been analyzed as per respective method claims 2-10. All limitations have been recited in the cited reference.

Claims 47-48 have been analyzed as per respective method claims 15 and 16. All limitations have been recited in the cited reference.

Claims 53, 57 and 58 have been analyzed as per respective method claims 2, 4 and 5. For hardware elements of the device please refer to Figures 2-4.

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Claim 54: network interface in communication with said central processor (see Figure 2).

Claim 55: storage device ..customer transaction records database.. (see Fig. 2 Buyer database).

Claims 56: said memory comprises a risk management module, transaction control module and an authentication module (see data storage device 250 having contract detail database 280, cryptographic key database 290 and CPO database which is accessible by CPU 205)

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 18, 19, 50 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker and further in view of Shavit et al. (US 4,799,156) (Shavit).

Per claim 18. Walker fails to teach the step of providing a shipping agent to ship goods, services, or other value from said second party to said first party.

Shavit, in the same field of endeavor teaches a method of facilitating commercial transactions. Shavit teaches providing a shipping agent (freight services) to ship goods, services, or other value from said second party (suppliers) (see Figure 2 and col. 5-6) to said first party (buyers).



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It would have been obvious to one of ordinary skill in the art at the time of invention to modify Walker as per Shavit to provide a shipping agent as claimed because it would provide facilitate communication for shipment of goods once the purchase conditions are met, thereby improving speed of shipment.

19. The method of claim 18, wherein the step of providing a shipping agent comprises maintaining by said transaction mechanism at least one of said first party's and said second party's identity and address in confidence with respect to either said first or said second party.

(refer to "Delayed Payment Embodiment", col. 22, note that the payment is carried out by the central controller who acts as an escrow agent).

Claims 50 and 51 have been analyzed as per respective method claims 18 and 19. All limitations have been recited in the cited reference.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (703)308-7837. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703)308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

12/27/04